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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/487,978	01/20/2000	Charles Eric Hunter	WT-5	3796

7590

05/31/2002

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EXAMINER

ELISCA, PIERRE E

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 05/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/487,978

Applicant(s)

Charles Eric, Hunter et al.

Examiner

Pierre E. Elisca

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 11, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above, claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 10 6) ☐ Other:

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DETAILED ACTION

Response to Amendment

1. This Office action is in response to Applicant's amendment filed on 3/11/2002.
2. Claims 34-51 are added and claims 1-51 are pending.
3. The rejection to claims 1 and 2 under 35 U.S.C. 103 (a) as being unpatentable over Kleiman (U.S. Pat. No. 5,959,945) in view of Looney et al. (U.S. Pat. No. 5,969,283) as set forth in the Office action mailed on 10/19/2001 is **maintained**.

REMARKS

4. In respond to claims 1 and 2, Applicant argues that the prior art of record do not teach or suggest alone or in combination:

“ a digital ID tag into the recorded music selections to identify the customer household at which the recording is made”. As specified by the Examiner in the Office action mailed on 10/9/2001, page 6, this limitation is disclosed by Looney in col 2, lines 51-54, specifically wherein it is stated that a music organizer and entertainment center wherein a CD-ROM and/or individual songs can include a special code or identification that is keyed to the user's system's code. In this manner only the user's system can load the songs on its hard drive, and therefore, this process is in fact equivalent to the limitation

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detailed above i.e ID tag or ID in the record music to identify the customer at which the recording is made. Accordingly, one of ordinary skill in the art would have been motivated to combine these references (Kleiman and Looney).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3-51 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Kleiman (U.S. Pat. No. 5,959,945) in view of LOONEY et al. (U.S. Pat. No. 5,969,283).

As per claims 3-51, Kleiman discloses the claimed system for distributing music to local, electronic jukeboxes see., abstract, lines 1 and 2 (which is seen to read on Applicant's claimed invention wherein said a system for distributing music to customer households), comprising: a data transmission system blanket transmitting a plurality of music selections (**this limitation is disclosed by Kleiman in the abstract, lines 5-9, specifically wherein it is stated that " a jukebox (or customer) selectively requests the transmission of songs from the central storage location**

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using a variety of communication means based upon usage data with respect to songs and the menu”);

a plurality of user stations at dispersed customer locations for receiving the transmitted music selections, each user station including means for a customer to select and record desired ones of the received music selections (this limitation is disclosed by Kleiman in the abstract, lines 9-14, specifically wherein it is stated that “the request can be initiated by the jukebox and can occur automatically based on statistics compiled by the jukebox representing user demand. The central storage location processes the requests and schedules individual requests from each jukebox to coordinate transmission of music to multiple locations simultaneously”, and also col 4, lines 21-31, col 6, lines 22-40, fig 1, ITs);

a communications link between each customer household and the central controller system to verify to the controller system when a preselected music selection has been recorded (this limitation is disclosed by kleiman in the abstract, lines 5-17, specifically wherein it is stated that “ a jukebox (or customer) selectively requests the transmission of songs from the central storage location using a variety of communication means based upon usage data with respect to songs and the menu. The central storage location periodically updates the local jukeboxes with a list of new releases, during which time the jukebox can also download (download or record) the music”, please note that the central storage location is readable as a central controller database, since it can coordinate transmission of music to multiple locations simultaneously and update the local jukeboxes, please also note that since the central storage location or central controller

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periodically updates, processes, and schedules individual requests from each jukebox or customer, during which time the jukebox or customer can download or copy the music, and therefore, can verify when music selection has been recorded or download or copy);

a billing system associated with the central controller system to bill customer households for music selections that are recorded (this limitation is disclosed by Kleiman in col 5, lines 16-28, specifically wherein it is stated “a secure environment for the transfer of music and other sensitive information for purchasing songs or paying (paying or billing) for services from the central location to each of the computer jukeboxes (jukeboxes or customer), please note that the secure environment of Kleiman is capable of billing the customer or jukeboxes for the music selection).

It is noted that Kleiman does not explicitly disclose that his central controller or central storage has an anti-piracy means or ID tag (or ID) in the recorded music to identify the customer at which the recording is made. However, Looney a music organizer and entertainment center wherein a CD-ROM and/ or individual songs can include a special code or identification that is keyed to the user's system's code. In this manner only the user's system can load the songs on its hard drive, see., Looney, col 2, lines 51-54 (which is equivalent to the limitation detailed above wherein said an anti-piracy means or ID tag or ID in the record music to identify the customer at which the recording is made). It is obvious to realize that within a billing system such as Kleiman, a payment transaction must be included. Kleiman further discloses the step of encoding/decoding keys see., abstract, specifically jukebox that includes secure hardware used to decrypt/encrypt music or keys.

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Accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the music distribution of **Kleiman** by including the membership customer ID or ID tag taught by **Looney** because such modification would provide the music distribution of **Kleiman** with the advantage of having an individual anti-piracy means or ID for customers, the customer can have a library of music to playback in a variety of portable and fixed base units (see., Looney, col 2, lines 56-58).

Conclusion

7. Any inquiry concerning this communication from the examiner should be directed to Pierre Eddy Elisca at (703) 305-3987. The examiner can normally be reached on Tuesday to Friday from 6:30AM to 5:00PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9769.

Any response to this action should be mailed to :

Commissioner of Patents of Trademarks

Washington, D. C. 20231

or faxed to :

(703) 308-9051, (for formal communications intended for entry)

OR :

(703) 305-3718, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

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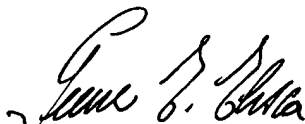
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA.,
Sixth floor (receptionist).

The Official Fax Numbers For TC-2100 Are:

After-Final (703) 746-7238

Official (703) 746-7239

Non-Official/Draft (703) 746-7240



Pierre Eddy Elisca

Patent Examiner

May 30, 2002